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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,250	06/30/2000	Tsuguhiro Korenaga	33216M050	2081

7590 02/25/2005

Beveridge DeGrandi weilacher & Young LLP
Suite 800
1850 M Street NW
Washington, DC 20036

EXAMINER

VARGOT, MATHIEU D

ART UNIT PAPER NUMBER

1732

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/609,250	KORENAGA ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11,14 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) 9,19-21,30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,10,11,14 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Upon reconsideration, dependent claims 10, 11 and 23-29 will be rejoined and examined along with Group I. Group III and IV claims, 9, 19-21, 30 and 31 will stand as non-elected for reasons already given.

2. Claims 1, 2, 5-8, 10, 11, 14 and 22-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant sets forth a range in claims 1 and 14 for the separating temperature when in fact no range has ever been set forth in the specification or claims as originally filed. I.e., applicant provides Table 1 that lists discrete separation temperatures of 80, 100, 120 and 150 deg C for the molding temperature of 180 deg C and separating temperatures for a molding temperature of 160 deg C. However, no **range** has ever been disclosed and it is submitted that the recitations "separating temperature that ranges from 120-150 deg C" in claim 1 and the corresponding limitation in claim 14 constitutes new matter.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 2, 5-8, 19, 11, 14 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gretschnier et al essentially for reasons of record noting the following.

Applicant has amended the independent method claims to recite merely the pressing temperature and the separating temperature. It is submitted that these aspects are in fact obvious over the applied reference, since exact temperatures would depend on the exact material being pressed. Arguments directed to unexpected results are not persuasive, since the results in instant Table 1—ie, the instant invention-- would clearly depend on factors such as the relative coefficients of expansion of the materials of the mold and that being pressed, the thickness of the substrate and the relative dimensions of the features being transcribed with respect to the thickness, and such is not set forth in claims 1 or 14. See the passage bridging pages 16 and 17 of the instant specification.

4. Applicant's arguments filed August 23, 2004 have been fully considered but they are not persuasive. Comments directed to the temperatures not being taught in Gretschnier et al and the allowability of the claims based on this fact are simply not persuasive for reasons noted above. As clearly indicated in the specification, it is not simply the temperatures alone but a number of other factors in combination with the temperatures which would provide such a showing, if such actually exists. These factors have not been set forth in the claims. The new matter concerning the range also needs to be addressed. Note that discrete temperatures do not provide support for a range of temperatures as now claimed.


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaiani, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
February 22, 2005


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

2/22/05